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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------|-------------|----------------------|-------------------------|------------------|
| 10/772,746 | 02/05/2004 | Edward Alan Knudson | 49102.3000.1.1 | 5722 |
| 22859 | 7590 | 10/10/2006 | EXAMINER | |
| INTELLECTUAL PROPERTY GROUP | | | MAYO, TARA L | |
| FREDRIKSON & BYRON, P.A. | | | | |
| 200 SOUTH SIXTH STREET | | | ART UNIT | PAPER NUMBER |
| SUITE 4000 | | | 3671 | |
| MINNEAPOLIS, MN 55402 | | | DATE MAILED: 10/10/2006 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/772,746 | KNUDSON ET AL. | |
| | Examiner Tara L. Mayo | Art Unit 3671 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 September 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 February 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 September 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 through 6, 9, 11 through 14, 17 and 19 through 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolbright (U.S. Patent No. 5,658,098) in view Roskin (U.S. Patent No. 7,000,347) and Bergevin (U.S. Patent No. 5,586,408).

Woolbright '098, as seen in Figures 2 through 8, a deterioration resistant retaining wall (45) comprising a plurality of planter blocks (20) positioned side-by-side and stacked to form a continuous retaining wall, said planter blocks including:
with regard to claim 13,

a bottom panel (22) and a wall assembly (24, 26) including a deterioration resistant material (col. 2, lines 40 through 48); and

at least one fill material (col. 2, lines 59 through 64);

wherein the block has at least one wall that borders each edge of the periphery of the planter block;

with regard to claim 14,

wherein the composite material is plastic;

with regard to claim 17,

wherein the top panel includes a removable cover;

with regard to claim 19,

wherein the planter blocks include more than one unit;

with regard to claim 20,

wherein the planter blocks further include one or more disengaging tabs (46);

with regard to claim 21,

wherein the planter blocks include one or more anchoring devices (60);

with regard to claim 22,

wherein the anchor device is a flange (62);

with regard to claim 23,

wherein each planter block is a unitary structure; and

with regard to claim 24,

wherein the apertures are positioned in a configuration to form a design.

Art Unit: 3671

Woolbright '098 fails to teach:

with regard to claim 13,

a top panel including a deterioration resistant composite or polymeric material;
vegetation seeds; and
a plurality of apertures positioned in the top panel.

Roskin '347, as seen in Figure 1 through 4, discloses a top panel (10) formed of a polymeric material (col. 4, lines 16 through 18) and including a plurality of apertures (20) positioned on the top panel to allow vegetation to visibly grow to the exterior of the deterioration resistant retaining wall.

Bergevin '408 expressly teaches the use of a fill material containing seeds (col. 6, lines 33 through 50).

With regard to claim 13, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device taught by Woolbright '098 such that it would further include a top panel with apertures as disclosed by Roskin '347. The motivation would have been to hold vegetation in a desired arrangement in the block.

With regard to claim 13, it would have been obvious to one having ordinary skill in the art of containment at the time of invention to modify the device shown by Woolbright '098 such that it would further include vegetation seeds in the fill material as taught to be known by Bergevin '408. The motivation would have been to include means for promoting vegetation.

With regard to claims 1 through 4, 6, 9, 11 and 12 the method steps recited therein are inherent to the construction and use of the device taught by the combination of Woolbright '098, Roskin '347 and Bergevin '408.

With specific regard to claim 5, while the combination of Woolbright '098, Roskin '347 and Bergevin '408 does not expressly teach construction of the retaining wall on a waterfront and all or a portion of the wall extending into the water, it would have been an obvious modification for one having ordinary skill in the art at the time of invention to construct the prior art retaining wall on a waterfront. The motivation would have been to effectively prevent erosion in an aesthetically pleasing manner.

4. Claims 7, 8, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolbright (U.S. Patent No. 5,658,098) in view Roskin (U.S. Patent No. 7,000,347) and Bergevin (U.S. Patent No. 5,586,408) as applied to claim 13 above, and further in view of Skuba (U.S. Patent No. 6,336,291).

The combination of Woolbright '098, Roskin '347 and Bergevin '408 fails to teach: with regard to claim 15,

the apertures being covered internally or externally by one or more aperture covers; with regard to claim 16,

the aperture cover including a biodegradable material.

Skuba '291, as seen in Figures 1 and 2, discloses an article (2) for growing plants comprising a biodegradable cover (32) placed atop a growing medium (18) provide protection from the wind and strong sunlight and retain moisture (col. 8, lines 47 through 60).

With regard to claims 15 and 16, it would have been obvious to one having ordinary skill in the art at the time of invention to modify the device disclosed by the combination of Woolbright '098, Roskin '347 and Bergevin '408 such that the apertures in the top panel would be covered internally by a biodegradable aperture cover as taught by Skuba '291. The motivation would have been to include means for retaining moisture in the fill material.

With regard to claims 7 and 8, the method steps recited therein are inherent to the construction and use of the device taught by the combination of Woolbright '098, Roskin '347 and Bergevin '408 as modified above by Skuba '291.

5. Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolbright '098, Roskin '347 and Bergevin '408 as applied to claim 13 above, and further in view of White-Wexler et al. (U.S. Patent No. 5,501,040).

The combination of Woolbright '098, Roskin '347 and Bergevin '408 fails to teach: with regard to claim 18,
at least one of the planter blocks further including one or more interior partitions.

White-Wexler et al. '040, as seen in Figures 1 through 4, show various configurations for a planter box (10), each planter including at least one partition (26, 28) for separating plants and soil from those in other compartments such that a mix of plants having differing soil and watering needs can be grown together within one planter (col. 1, lines 59 through 65; Claim 1).

With regard to claim 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device taught by the combination of Woolbright '098, Roskin '347 and Bergevin '408 such that at least one of the planter blocks would include at least one interior partition as taught by White-Wexler et al. '040. The motivation would have been to accommodate a variety of plants having different soil and watering needs within one block.

With regard to claim 10, the method steps recited therein are inherent to the construction and use of the device taught by the combination of Woolbright '098, Roskin '347 and Bergevin '408 as modified above by White-Wexler et al. '040.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 3, 4, 5, 6, 7, 9, 10, 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 or 7, 2, 3, 4, 5, 6, 8, 11, 12, 13 and 14 of U.S. Patent No. 6,571,529 B2 in view of Bergevin (U.S. Patent No. 5,586,408). Although the conflicting claims are not identical, they are not patentably distinct from each other.

With regard to claim 1, it would have been obvious to one having ordinary skill in the art of retaining walls at the time the invention was made to modify the method claimed by U.S. Patent No. '529 such that it would include a plurality of apertures. The motivation would have been to provide additional openings for plant growth. Furthermore, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With regard to claim 1, Bergevin '408 expressly teaches the use of a fill material containing seeds (col. 6, lines 33 through 50). Therefore, it would have been obvious to one having ordinary skill in the art of retaining walls at the time the invention was made to modify the method claimed by U.S. Patent No. '529 such that it would include fill material and vegetation seeds as taught to be known by Bergevin '408. The motivation would have been to promote plant growth in the block.

8. Claims 1, 2, 3, 4, 13, 15 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 or 17, 15, 17, 18, 19, 19 and 19 of U.S. Patent No. 6,695,544 B2 in view of Bergevin (U.S. Patent No. 5,586,408). Although the conflicting claims are not identical, they are not patentably distinct from each other.

With regard to claim 1, it would have been obvious to one having ordinary skill in the art of retaining walls at the time the invention was made to modify the device claimed by U.S. Patent No. '544 such that it would include a plurality of apertures. The motivation would have been to provide additional openings for plant growth. Furthermore, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With regard to claim 1, Bergevin '408 expressly teaches the use of a fill material containing seeds (col. 6, lines 33 through 50). Therefore, it would have been obvious to one having ordinary skill in the art of retaining walls at the time the invention was made to modify the device claimed by U.S. Patent No. '544 such that it would include fill material and vegetation

seeds as taught to be known by Bergevin '408. The motivation would have been to promote plant growth in the block.

9. Claims 13, 14, 15, 17, 18, 19, 20, 21, 22 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 or 3, 2, 4, 7, 8, 9, 10, 11, 12 and 14 of U.S. Patent No. 6,817,154 (formerly copending Application No. 10/331,407) in view of Bergevin (U.S. Patent No. 5,586,408). Although the conflicting claims are not identical, they are not patentably distinct from each other.

With regard to claim 13, it would have been obvious to one having ordinary skill in the art of retaining walls at the time the invention was made to modify the device claimed by U.S. Patent No. '154 such that it would include a plurality of apertures. The motivation would have been to provide additional openings for plant growth. Furthermore, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With regard to claim 13, Bergevin '408 expressly teaches the use of a fill material containing seeds (col. 6, lines 33 through 50). Therefore, it would have been obvious to one having ordinary skill in the art of retaining walls at the time the invention was made to modify the device claimed by U.S. Patent No. '154 such that it would include fill material and vegetation seeds as taught to be known by Bergevin '408. The motivation would have been to plant growth in the block.

Response to Arguments

10. Applicant's arguments filed 21 September 2006 have been fully considered but they are not persuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 571-272-6992. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tlm

29 September 2006



TARA L MAYO
PATENT EXAMINER